

Application Serial No. 10/665,708

Confirmation No. 6892

Filed: September 18, 2003

Atty. Docket No. GP107-03.DV1

RESPONSE TO RESTRICTION REQUIREMENT &amp; PRELIMINARY AMENDMENT

### Response to Restriction Requirement

Claims 1-20 are pending, following entry of the Preliminary Amendment that was filed with this divisional application on September 18, 2003. A restriction to one of the following inventions was issued in the Office action mailed April 7, 2006:

- I. Claims 1-12, drawn to methods for detecting mycobacterium, and
- II. Claims 13-20, drawn to compositions.

Although Applicants agree that the inventions claimed in Groups I and II are distinct as provided in MPEP § 806.05(h), Applicants respectfully traverse the requirement and request that the claims be examined together. Applicants believe that the claims of Groups I and II are sufficiently closely related that a search required to examine the compositions of Group II claims will overlap with a search for art relevant to the Group I method claims. That is, because the method claims include the same oligonucleotide sequences contained in the composition claims, a search of the oligonucleotide sequences will likely reveal art relevant to methods that use such sequences. Applicants, therefore, respectfully submit that it would not place a serious burden on the Office to search the art or examine the claims together. Applicants respectfully request that the Examiner reconsider this restriction requirement.

If the restriction requirement is not withdrawn, Applicants elect Group II (claims 13-20), drawn to compositions comprising oligonucleotides, and withdraw from examination the claims of Group I (claims 1-12). The list of claims in this response shows the status of the claims if this restriction requirement is maintained.

Applicants thank the Examiner for the reminder that process claims that depend from or otherwise include all the limitations of a product claim that is found patentable will be rejoined as a matter of right (MPEP § 821.04), consistent with the rules for amendments found in 37 CFR 1.116 and 1.312, and examined for patentability (37 CFR 1.104). If the restriction requirement is maintained,

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Applicants request that the withdrawn claims be rejoined and examined in the event that composition claims are found allowable.

### Preliminary Amendment to Claim 13

Applicants have amended elected claim 13 for clarity by inserting language to make clear that the DNA referred to is "DNA encoding the Mycobacterium 16S rRNA" and that the 18 contiguous bases referred to are "contained in" SEQ ID NO:24. Applicants request entry of this amendment before examination of the claims.

The undersigned believes that this communication responds fully to the Office communication mailed April 7, 2006 and regrets any inconvenience to the Examiner for not resolving this election by the telephone call of March 20, 2006. If other matters remain that can be resolved by telephone, the Examiner is invited to contact the undersigned at the number provided below.

No fee is believed due in connection with this timely response. If Applicants are incorrect, authorization is hereby provided to debit required fees from Deposit Account No. 07-0835 maintained by Gen-Probe Incorporated.

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. 571-273-8300) on the date shown below.

Respectfully Submitted,

Dated: May 5, 2006

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